

ESTTA Tracking number: **ESTTA227477**

Filing date: **07/31/2008**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Rodale Inc.
Granted to Date of previous extension	08/31/2008
Address	33 East Minor Street Emmaus, PA 18098-0099 UNITED STATES
Attorney information	Kevin G. Smith, Esq. Sughrue Mion, PLLC 2100 Pennsylvania Avenue, N.W.Suite 800 Washington, DC 20037-3213 UNITED STATES vmullineaux@sughrue.com, ksmith@sughrue.com, tberget@williamsmullen.com Phone:202-293-7060

Applicant Information

Application No	77166591	Publication date	03/04/2008
Opposition Filing Date	07/31/2008	Opposition Period Ends	08/31/2008
Applicant	U.S. Preventive Medicine, Inc. 1004 Woodcliff Drive McKinney, TX 75070 UNITED STATES		

Goods/Services Affected by Opposition

<p>Class 041.</p> <p>All goods and services in the class are opposed, namely: Personal coaching services in the fields of health, nutrition, wellness, weight loss, diet, exercise and personal habits; organizing and conducting educational conferences, seminars and orientation meetings for health care institutions, physicians, health care providers and staff in the fields of health, nutrition, wellness, weight loss, diet, exercise and personal habits; providing information in the field of exercise training on behalf of physicians and health care providers via an online interactive network; providing electronic links for physicians to the websites of others in the field of exercise training</p>
<p>Class 044.</p> <p>All goods and services in the class are opposed, namely: Medical services, namely, medical, psychiatric, genetic and behavioral health risk testing; providing information in the field of health, nutrition, wellness, weight loss, diet and personal habits, namely, smoking and alcohol use, to health care institutions on behalf of physicians and health care providers via an online interactive network; providing electronic links for physicians to the websites of others in the field of health, nutrition, wellness, weight loss, diet and personal habits, namely, smoking and alcohol use</p>

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	1470533	Application Date	05/13/1987
Registration Date	12/29/1987	Foreign Priority Date	NONE
Word Mark	PREVENTION		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 1986/12/31 First Use In Commerce: 1987/01/10 [BINOCULARS, TAPE MEASURES AND PEDOMETERS] Class 016. First use: First Use: 1986/10/21 First Use In Commerce: 1986/11/01 [NOTEPADS, RECIPE CARDS AND FILES] Class 024. First use: First Use: 1986/08/20 First Use In Commerce: 1986/09/00 [TOWELS] Class 025. First use: First Use: 1985/10/07 First Use In Commerce: 1985/11/01 [APRONS, HEADBANDS,] HATS [, VISORS] AND SHIRTS		

U.S. Registration No.	694267	Application Date	06/22/1959
Registration Date	03/08/1960	Foreign Priority Date	NONE
Word Mark	PREVENTION		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class U038 (International Class 016). First use: First Use: 1950/06/00 First Use In Commerce: 1950/06/00 MAGAZINE		

U.S. Registration No.	1914946	Application Date	08/11/1994
Registration Date	08/29/1995	Foreign Priority Date	NONE
Word Mark	PREVENTION		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 018. First use: First Use: 1986/04/00 First Use In Commerce: 1986/04/00 umbrellas Class 028. First use: First Use: 1993/05/00 First Use In Commerce: 1993/05/00 golf balls		

U.S. Registration No.	2222899	Application Date	03/20/1998
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Registration Date	02/09/1999	Foreign Priority Date	NONE
Word Mark	PREVENTION HEALTH BOOKS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 016. First use: First Use: 1998/01/02 First Use In Commerce: 1998/01/06 SERIES OF BOOKS ON HEALTH, FITNESS, DIET, EXERCISE AND LIFESTYLE		

U.S. Registration No.	1464064	Application Date	07/03/1986
Registration Date	11/03/1987	Foreign Priority Date	NONE
Word Mark	PREVENTION WALKING CLUB		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 200. First use: First Use: 1986/03/17 First Use In Commerce: 1986/03/17 INDICATING MEMBERSHIP IN AN ORGANIZATION WHICH IS A CLUB DIRECTED TO THOSE WHOSE INTEREST IN FITNESS RELATES TO THE EXERCISE OF WALKING		

U.S. Registration No.	1455284	Application Date	02/09/1987
Registration Date	09/01/1987	Foreign Priority Date	NONE
Word Mark	PREVENTION'S FAMILY HEALTH LIBRARY		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 016. First use: First Use: 1987/01/06 First Use In Commerce: 1987/01/06 SERIES OF HEALTH-RELATED BOOKS PUBLISHED PERIODICALLY		

U.S. Registration No.	1959078	Application Date	05/12/1995
Registration Date	02/27/1996	Foreign Priority Date	NONE
Word Mark	PREVENTION'S GUIDE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 016. First use: First Use: 1992/12/00 First Use In Commerce: 1992/12/00 magazine in the field of health, fitness, diet, exercise and related lifestyle issues		

U.S. Registration No.	2550507	Application Date	06/01/1999
Registration Date	03/19/2002	Foreign Priority Date	NONE
Word Mark	PREVENTION		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 009. First use: First Use: 1988/00/00 First Use In Commerce: 1988/00/00 PRE-RECORDED AUDIO AND VIDEO CASSETTES AND CDS IN THE FIELD OF HEALTH, FITNESS, DIET, EXERCISE AND HEALTHY LIFESTYLES Class 025. First use: First Use: 1988/00/00 First Use In Commerce: 1988/00/00 SHIRTS, HATS, [RUNNING SUITS, SWEATSUITS, VISORS, PANTS, SHORTS AND RAINWEAR]

U.S. Registration No.	2643325	Application Date	06/01/1999
Registration Date	10/29/2002	Foreign Priority Date	NONE
Word Mark	PREVENTION		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 1998/00/00 First Use In Commerce: 1998/00/00 production of radio and television programs; and entertainment services, namely, a continuing series of programs in the fields of health, fitness, diet, exercise and lifestyle distributed over radio, television, satellite, cable, audio and visual media, and via a global computer network Class 042. First use: First Use: 1998/00/00 First Use In Commerce: 1998/00/00 information services in the fields of health, fitness, diet, exercise and lifestyle provided electronically via a web site on a multi-user global computer information network; and electronic publications via the world wide web containing on-line magazines, columns and articles in the fields of health, fitness, diet, exercise and lifestyle		

U.S. Registration No.	2964475	Application Date	06/18/2002
Registration Date	07/05/2005	Foreign Priority Date	NONE
Word Mark	PREVENTION		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 1999/05/00 First Use In Commerce: 1999/05/00 PROMOTING THE GOODS AND SERVICES OF OTHERS THROUGH THE DISTRIBUTION OF PRODUCTS, SAMPLES AND COUPONS AT A MOBILE HEALTH EXHIBIT		

U.S. Registration No.	2968489	Application Date	07/21/2003
Registration Date	07/12/2005	Foreign Priority Date	NONE
Word Mark	PREVENTION FITNESS SYSTEM		
Design Mark			
Description of Mark	NONE		

Goods/Services	Class 009. First use: First Use: 2003/09/00 First Use In Commerce: 2003/09/00 PRE-RECORDED VIDEO TAPES FEATURING WORKOUT ROUTINES		
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U.S. Registration No.	2985760	Application Date	05/06/2002
Registration Date	08/16/2005	Foreign Priority Date	NONE
Word Mark	PREVENTION		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 005. First use: First Use: 2005/04/15 First Use In Commerce: 2005/04/15 [ADHESIVE BANDAGES FOR SKIN WOUNDS; AIR DEODORANT AND AIR FRESHENERS; APPETITE SUPPRESSANTS,] DIETARY FOOD SUPPLEMENTS AND FOOD SUPPLEMENTS; [NUTRITIONAL AND DIETARY DRINK MIX FOR USE AS A MEAL REPLACEMENT; MEDICATED HAIR CARE PREPARATIONS AND SHAMPOO;] HERBAL SUPPLEMENTS AND NUTRITIONAL SUPPLEMENTS; VITAMINS AND MINERAL SUPPLEMENTS; [DENTAL RINSE; MEDICATED SKINCARE PREPARATIONS AND MEAL REPLACEMENT DRINKS]		

U.S. Registration No.	3006983	Application Date	11/12/2003
Registration Date	10/18/2005	Foreign Priority Date	NONE
Word Mark	PREVENTION.COM		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 035. First use: First Use: 2001/10/00 First Use In Commerce: 2001/10/00 ADVERTISING SERVICES, NAMELY, PROMOTING THE GOODS AND SERVICES OF OTHERS BY PROVIDING A WEB SITE AT WHICH USERS CAN OBTAIN INFORMATION AND CAN ACCESS WEB SITE LINKS FOR PRODUCTS AND SERVICES IN THE FIELD OF HEALTH, FITNESS, DIET, EXERCISE, LIFESTYLE, NUTRITION AND WEIGHT LOSS; ADMINISTRATION OF A DISCOUNT PROGRAM FOR ENABLING PARTICIPANTS TO OBTAIN DISCOUNTS ON GOODS AND SERVICES THROUGH THE USE OF A DISCOUNT MEMBERSHIP PLAN</p> <p>Class 038. First use: First Use: 2001/10/00 First Use In Commerce: 2001/10/00 Providing on-line electronic bulletin boards for transmission of messages among computer users concerning health, fitness, exercise, lifestyle, nutrition and weight loss</p> <p>Class 041. First use: First Use: 2001/10/00 First Use In Commerce: 2001/10/00 COMPUTER SERVICES, NAMELY, PROVIDING ON-LINE MAGAZINES AND NEWSLETTERS IN THE FIELD OF HEALTH, FITNESS, DIET, EXERCISE, LIFESTYLE, NUTRITION AND WEIGHT LOSS</p> <p>Class 044. First use: First Use: 2001/10/00 First Use In Commerce: 2001/10/00 Providing a web site on a global computer network featuring information in the field of health, fitness, diet, exercise, healthy lifestyle, nutrition and weight loss</p>		

U.S. Registration No.	3100542	Application Date	05/25/2005
Registration Date	06/06/2006	Foreign Priority	NONE

		Date	
Word Mark	GOOD HEALTH STARTS WITH PREVENTION		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 005. First use: First Use: 2005/04/15 First Use In Commerce: 2005/04/15 DIETARY FOOD SUPPLEMENTS AND FOOD SUPPLEMENTS; HERBAL SUPPLEMENTS AND NUTRITIONAL SUPPLEMENTS; VITAMINS AND MINERAL SUPPLEMENTS		

U.S. Registration No.	3127258	Application Date	05/06/2002
Registration Date	08/08/2006	Foreign Priority Date	NONE
Word Mark	PREVENTION		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 010. First use: First Use: 2005/11/00 First Use In Commerce: 2005/11/00 Heart monitors and blood pressure monitors		

U.S. Registration No.	3161878	Application Date	05/02/2005
Registration Date	10/24/2006	Foreign Priority Date	NONE
Word Mark	PREVENTION		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 016. First use: First Use: 2005/05/00 First Use In Commerce: 2005/05/00 Calendars		

U.S. Registration No.	3201866	Application Date	03/23/2006
Registration Date	01/23/2007	Foreign Priority Date	NONE
Word Mark	PREVENTION		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 016. First use: First Use: 2005/05/00 First Use In Commerce: 2005/05/00 Desk and wall calendars; appointment books; diaries; scheduling books; time planner books		

Related Proceedings	Opposition No. 91181264; Cancellation No. 92049148
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Kevin G. Smith/
Name	Kevin G. Smith, Esq.
Date	07/31/2008

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re Application Serial No. 77/166,591
Mark: YES TO PREVENTION

RODALE INC.,

Opposer,

v.

U.S. PREVENTIVE MEDICINE, INC.,

Applicant.

Opposition No. _____

NOTICE OF OPPOSITION

Rodale Inc., a Pennsylvania corporation, with a business address of 33 East Minor Street, Emmaus, Pennsylvania 18098-0099, hereby opposes the registration of the mark YES TO PREVENTION, which is the subject of Application Serial No. 77/166,591, filed April 26, 2007, and published March 4, 2008.

As grounds in support of this opposition, Opposer alleges as follows:

1. Opposer Rodale Inc. is a Pennsylvania corporation with a business address of 33 East Minor Street, Emmaus, Pennsylvania 18098-0099.
2. For many years, and since long prior to any date of first use upon which applicant can rely, Opposer has adopted, used and registered various marks which comprise or include the term PREVENTION, either by itself, or together with another word or words, for various products and services in the health, nutrition, diet and exercise field, and related collateral products and services.

3. Opposer is the owner of the following United States Principal Register

registrations which are valid, subsisting, unrevoked and uncanceled:

MARK	REG. NO.	ISSUE DATE	GOODS/SERVICES
PREVENTION	1,470,533	12/29/87	Tape measures, note pads, recipe cards and files, towels, aprons, headbands, hats, visors and shirts
PREVENTION	694,267	03/08/60	Magazine
PREVENTION	1,914,946	08/29/95	Umbrellas and golf balls
PREVENTION HEALTH BOOKS	2,222,899	02/09/99	Series of books on health, fitness, diet, exercise, and lifestyle
PREVENTION WALKING CLUB	1,464,064	11/03/87	Indicating membership in an organization which is a club directed to those whose interest in fitness relates to the exercise of walking
PREVENTION'S FAMILY HEALTH LIBRARY	1,455,284	09/01/87	Series of health-related books published periodically
PREVENTION'S GUIDE	1,959,078	02/27/96	Magazine in the field of health, fitness, diet, exercise and related lifestyle issues
PREVENTION	2,550,507	03/19/02	Pre-recorded audio and video cassettes and cds in the field of health, fitness, diet, exercise and healthy lifestyles; shirts, hats, running suits, sweatsuits, visors, pants, shorts and rainwear
PREVENTION	2,643,325	10/29/02	Production of radio and television programs; and entertainment services, namely, a continuing series of programs in the fields of health, fitness, diet, exercise and lifestyle distributed over radio, television, satellite, cable, audio and visual media, and via a global computer network; Information services in the fields of health, fitness, diet, exercise and lifestyle provided electronically via a web site on a multi-user global computer information network; and electronic publications via the world wide web containing on-line magazines, columns and articles in the fields of health, fitness, diet, exercise and lifestyle

MARK	REG. NO.	ISSUE DATE	GOODS/SERVICES
PREVENTION	2,964,475	07/05/05	Promoting the goods and services of others through the distribution of products, samples and coupons at a mobile health exhibit
PREVENTION FITNESS SYSTEM	2,968,489	07/12/05	Pre-recorded video tapes featuring workout routines
PREVENTION	2,985,760	08/16/05	Dietary food supplements and food supplements; herbal supplements and nutritional supplements; vitamins and mineral supplements
PREVENTION.COM	3,006,983	10/18/05	Advertising services, namely, promoting the goods and services of others by providing a web site at which users can obtain information and can access web site links for products and services in the field of health, fitness, diet, exercise, lifestyle, nutrition and weight loss; administration of a discount program for enabling participants to obtain discounts on goods and services through the use of a discount membership plan; providing on-line electronic bulletin boards for transmission of messages among computer users concerning health, fitness, diet, exercise, lifestyle, nutrition and weight loss; computer services, namely, providing on-line magazines and newsletters in the field of health, fitness, diet, exercise, lifestyle, nutrition and weight loss; providing a web site on a global computer network featuring information in the field of health, fitness, diet, exercise, healthy lifestyle, nutrition and weight loss
GOOD HEALTH STARTS WITH PREVENTION	3,100,542	06/06/06	Dietary food supplements and food supplements; herbal supplements and nutritional supplements; vitamins and mineral supplements
PREVENTION	3,127,258	08/08/06	Heart monitors and blood pressure monitors
PREVENTION	3,161,878	10/24/06	Calendars
PREVENTION	3,201,866	01/23/07	Desk and wall calendars; appointment books; diaries; scheduling books; time planner books

4. Opposer has long used the mark PREVENTION in connection with providing healthcare information and health screening and testing services. Therefore, the mark has become distinctive in association with such services and identifies Opposer as the source of such services rendered under the PREVENTION mark.

5. As a result of Opposer's long use of its PREVENTION marks and its extensive advertising and promotion of the various products and services under the PREVENTION marks, Opposer's PREVENTION marks have become exclusively associated with products and services originating with Opposer, have become extremely well known to the public and have become famous.

6. Applicant, on April 26, 2007, filed an application for the mark YES TO PREVENTION, which was assigned Application Serial No. 77/166,591. That application was filed based on intent to use and covers services described as "Personal coaching services in the fields of health, nutrition, wellness, weight loss, diet, exercise and personal habits; organizing and conducting educational conferences, seminars and orientation meetings for health care institutions, physicians, health care providers and staff in the fields of health, nutrition, wellness, weight loss, diet, exercise and personal habits; providing information in the field of exercise training on behalf of physicians and health care providers via an online interactive network; providing electronic links for physicians to the websites of others in the field of exercise training," in Class 41 and "Medical services, namely, medical, psychiatric, genetic and behavioral health risk testing; providing information in the field of health, nutrition, wellness, weight loss, diet and personal habits, namely, smoking and alcohol use, to health care institutions on behalf of physicians and health care providers via an online interactive network; providing electronic links for physicians to the websites of others in the field of health, nutrition, wellness,

weight loss, diet and personal habits, namely, smoking and alcohol use," in Class 44. The application was published for opposition on March 4, 2008.

7. Applicant's mark, for the services described in Applicant's Application Serial No. 77/166,591, so resembles Opposer's previously used and registered PREVENTION marks as to be likely, when applied to applicant's services, to cause confusion, mistake or deception.

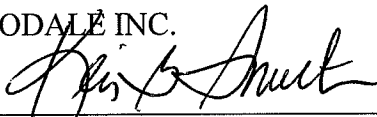
WHEREFORE, Opposer believes it will be damaged by the registration of Applicant's mark and prays that this opposition be sustained and the registration of Application Serial No. 77/166,591 be denied.

Please charge the \$600.00 opposition fee to the undersigned's Deposit Account No. 19-4880. Please charge any deficiency or credit any overpayment to Deposit Account No. 19-4880.

Respectfully submitted,

RODALE INC.

By:



Kevin G. Smith
Gary D. Krugman
Attorneys for Opposer
SUGHRUE MION, PLLC
2100 Pennsylvania Avenue, N.W.
Washington, D.C. 20037-3202
Phone: (202) 663-7927
Fax: (202) 331-4308

Date: July 31, 2008

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing **NOTICE OF OPPOSITION** has been served on Applicant this 31st day of July 2008 via first class mail, postage prepaid to:

Thomas F. Bergert, Esq.
WILLIAMS MULLEN P.C.
8270 Greensboro Drive
Suite 700
McLean, Virginia 22102
Attorney for Applicant

A handwritten signature in black ink, appearing to read "Kevin G. Smith", written over a horizontal line.

Kevin G. Smith